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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,159	12/21/2001	Douglas Deeds	042933/297034	5211

826 7590 05/05/2008

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EXAMINER	
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ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
05/05/2008	PAPER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS DEEDS,
DEMETRIOS BOUTSIKAKIS, and
ANDREW WILKEN

Appeal 2008-1448
Application 10/029,159
Technology Center 3600

Decided: May 5, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and MICHAEL W. O'NEILL, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Douglas Deeds, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 21-27 and 33-42. Claims 1-20 and 28-32 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.[1]

THE INVENTION

The invention relates to a method and system for delivering content to and locking content in a user's communication device such as a wireless mobile device. In accordance with the invention, "a user of the user device allows the content to be locked for a specified period of time or a specified amount of usage in exchange for a specified reward from a business entity associated with the content." (Specification 2:10-12). In an embodiment of the invention, the method of locking content in the user device involves receiving a lock message, including terms of a locking option and content data. The terms of the locking option are provided to the user and acceptance of those terms are received from the user. Content in the user device is then revised based on the content data and locked in accordance with the locking requirement based on the accepted terms of the locking option. (Specification 2:18-3:2). "In a particular embodiment, a reward is offered to a user of the user device in exchange for allowing the content to be locked in the user device for a specified period of time or for a specified amount of usage." (Specification 3:4-7).

Claims 21 and 35 are illustrative of the invention.

> 21. A method at a network based device for providing selected content to a user device, said method comprising:
>
> receiving an indication of selected content;

[1] Our decision will make reference to Appellant's "Revised" Appeal Brief ("Br.," filed Sep. 6, 2006) and the Examiner's Answer ("Answer," mailed Dec. 6, 2006).

presenting at least one locking requirement including a first locking requirement associated with the selected content to the user device;

receiving a selection of at least the first locking requirement at the network based device from the user device in response to presenting the at least one locking requirement; and

providing the selected content from the network based device to the user device together with the at least the first locking requirement following selection of the content and at least the first locking requirement to permit the selected content to be operated upon pursuant to the at least the first selected locking requirement.

35. In a wireless mobile device operable by a user in a radio communication system, an improvement of apparatus for operating upon selected content selected from a plurality of content stored at a network-based device and delivered to the wireless mobile device, said apparatus comprising:

a content manager embodied at the wireless mobile device, said content manager for managing the selected content once delivered to the wireless mobile device, management of the selected content provided by said content manager comprising selectably locking the selected content pursuant to a first selected locking requirement such that the selected content is repeatedly presented until the first selected locking requirement is met, determining when the first selected locking requirement is met, and unlocking the selected content when the first selected locking requirement is determined to have been met such that the selected content is no longer required to be repeatedly presented.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Shin	US 2002/0010698 A1	Jan. 24, 2002

The following rejection is before us for review:

- Claims 21-27 and 33-42 are rejected under 35 U.S.C. § 102(e) as being anticipated by Shin.

ISSUES

The issue is whether the Appellants have shown that the Examiner erred in rejecting claims 21-27 and 33-42 as being anticipated by Shin. A major issue is whether Shin describes the claimed locking requirement.

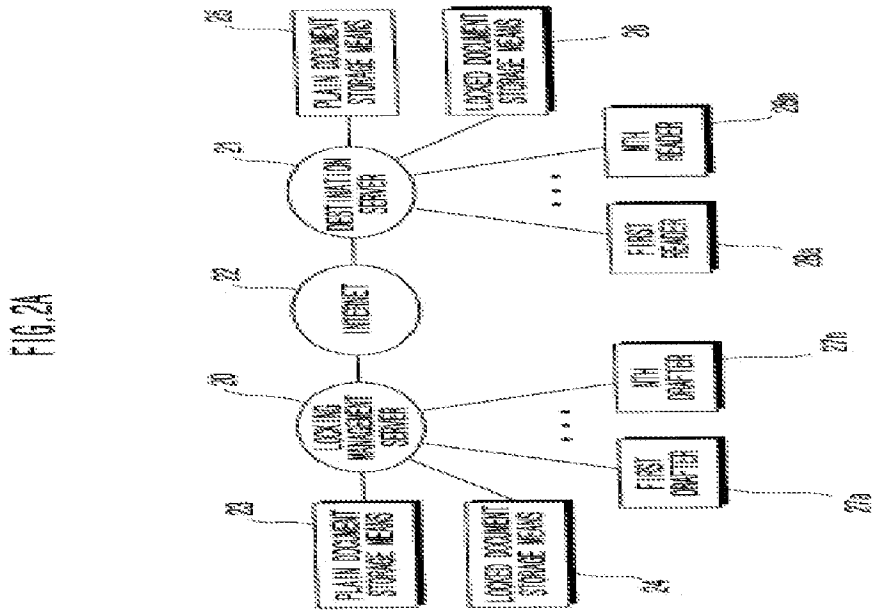
FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office). Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

1. The Examiner found that Shin explicitly describes all the claimed limitations.
2. Referring to Figs. 2A, 2B, and 4, and paragraphs 0010, 0011, 0022, and 0023, of Shin, the Examiner states that Shin describes "receiving a selection of at least the first locking requirement at the network based device from the user device in response to presenting the at least one locking requirement, and providing the selected content from

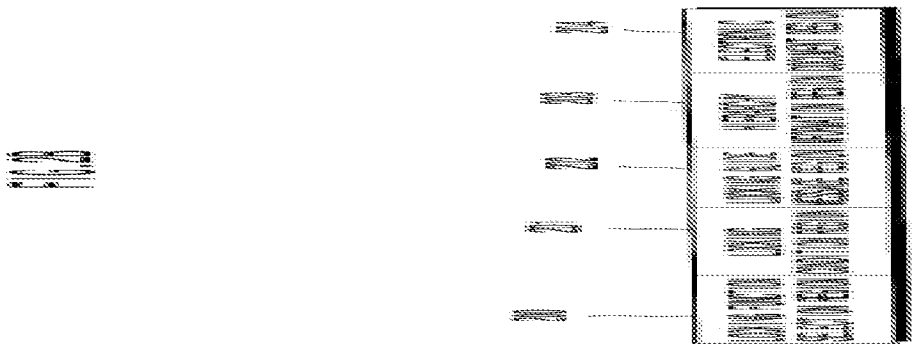
the network based device to the user device together with the at least the first locking requirement following selection of the content and at least the first locking requirement to permit the selected content to be operated upon pursuant to the at least the first selected locking requirement" (Answer 3-4, quoting from claim 1).

3. Shin Fig. 2A is reproduced below:



Shin Fig. 2A is said to depict "a preferred embodiment of an electronic document transmission system with locking function according to the present invention" ([0016]).

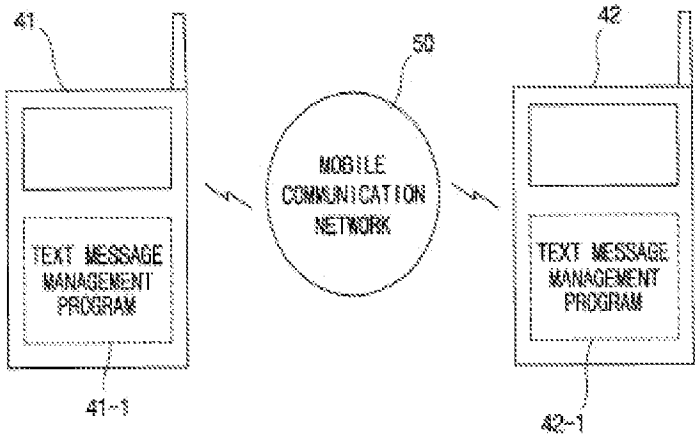
4. Shin Fig. 2B is reproduced below:



Shin Fig. 2B is said to depict "a structure of a locked document according to the present invention" ([0017]).

5. Shin Fig. 4 is reproduced below:

FIG. 4



Shin Fig. 4 is said to depict "a schematic diagram showing a connection between mobile phones and a mobile communication network" ([0021]).

6. Shin paragraph 0010 states:

[0010] To accomplish these and other objects described in the detailed description, there is provided a method of applying locking function to an electronic document over the Internet through a locking management server having a locked document storage means in which a locked document comprised of locking function selection region, a locking condition region, a locking guide message region, a hierarchy information region and an electronic document region, is stored, and a plain document storage means in which a plain electronic document is

stored, comprising the steps of (1) preparing an electronic document, and (2) reading the electronic document, wherein the step (1) comprises preparing an electronic document and storing hierarchy information, determining whether locking function is applied to the electronic document or not, enabling a locking condition and a locking guide message to be input if the locking function is selected, storing the electronic document in the locking document storage means if the locking function is selected, if not selected, storing the electronic document in the plain document storage means, and the step (2) comprises determining whether the electronic document to be read by the reader is locked or not, transmitting the electronic document to be read if not locked, enabling to input the locking condition if locked, allowing the reader to read the locked document if the locking condition is satisfied, and displaying the locking guide message if the locking condition is not satisfied.

7. Shin paragraph 0011 states:

[0011] The method of applying locking function to electronic documents according to the present invention can also be employed in transmission/reception of text messages through mobile phones. In this case, a message preparing step and a message reading step corresponding to an electronic document preparing step and an electronic document reading step, respectively, can be preferably performed in a text message management program loaded on a mobile phone.

8. Shin paragraph 0022 states:

[0022] Referring to FIG. 2A showing a preferred embodiment of an electronic document transmission system with locking function according to the present invention, wherein the electronic document transmission system includes a locking function management server 20 and a destination server 21 having plain document storage means 23 and 25, locked document storage means 24 and 26, respectively, first through Nth drafters 27a through 27n that connect to the locking function management server 20, first through Nth readers 28a through 28m that connect to the destination server 21, and the Internet 22 through which the locking function management server 20 and the destination server 21 is connected. In detail, since the first through Nth drafters 27a through 27n may prepare a plain electronic document

(which is not locked) or a locked electronic document, the locking function management server 20 that has the capability of applying locking function to an electronic document, includes the plain document storage means 23 and the locked document storage means 24, as described above. Also, if the destination server 21 is the one that has the capability of applying locking function to an electronic document, it may include the plain document storage means 25 and the locked document storage means 26. If not, the destination server 21 may include only a plain electronic document storage means, like the storage means 5 shown in FIG. 1A, in which both the plain document and the locked document can be stored.

9. Shin paragraph 0023 states:

[0023] FIG. 2B shows a structure of a locked document according to the present invention, including a locking function selection region 200, a locking condition region 201, a locking guide message region 202, a hierarchy information region 203, and an electronic document region 204. The locking function selection region 200 stores the information whether locking function is applied to the attached electronic document. For example, if the locking function selection region 200 is represented by 0, it implies that locking function is not applied to the document. If the locking function selection region 200 is represented by 1, it implies that locking function is applied thereto. Various conditions for locking the attached electronic document can be stored in the locking condition region 201. For example, the date on which the attached electronic document can be open, the specified reader or questions for quiz can be provided. That is to say, if the date on which the attached electronic document can be open is set, e.g., 10:30 am Oct. 5, 2000 (dd-mo-yr), the attached electronic document cannot be open before the date. If the reader is specified, e.g., name, resident number, address, or the school from one graduated, the one other than the specified reader can not open the attached electronic document. If questions for quiz are suggested, a predetermined quiz and the answer thereto, e.g., question "1+1" and answer "2", are stored in the locking condition region 201. The attached document can only be seen on condition that the correct answer is provided. If more than one locking methods are selected, locking conditions corresponding thereto can be stored successively. The locking guide message region 202 is a region necessary for presenting a guide message to anyone

> who does not satisfy the locking condition specified by the drafter. For example, if the reading commencement date has not been reached, a guide message saying "please wait." is presented with the remaining time. If one who is not the specified reader tries to read the electronic document, a guide message saying "You are not the right person." is presented. If the answer to the quiz is wrong, a guide message saying "Incorrect." is presented. In the hierarchy information region 203, the name of a drafter (or sender) who has prepared the locked document is stored. That is to say, the name (or ID) of the drafter who has prepared the locked document first is recorded in the hierarchy information region 203. In the case when a reader who has read the locked document makes a reply to the locked document, the name of the reader is added after the drafter's name stored in the hierarchy information region 203. Likewise, names of readers who add more contents to the original document are stored in the hierarchy information region 203.

PRINCIPLES OF LAW

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

ANALYSIS

The Examiner found that Shin describes all the claimed limitations. (Answer 3-6.) The Appellants disagreed.

The Appellants have presented arguments directed to claims 21, 22, 26, 33, 34, 35, 36, 38, 39, and 41. The remaining claims, i.e., claims 23-25, 27, 37, 40, and 42 have not been separately argued. Thus, claims 23-25, 27, 37, 40, and 42 will stand or fall with the claims on which they depend.

The Appellants made six arguments: (1) "Shin does not describe a method wherein the selected content and the locking requirement are provided to the user device in order to permit the selected content to be operated upon pursuant to the locking requirement, as required by independent Claims 21 and 22." Br. 6. (2) "Shin does not describe a method wherein the user device that receives the selected content is the same user device that is also presented with and selects a locking requirement, as further required by independent Claims 21 and 22." Br. 8. (3) "Shin does not describe a content manager capable of locking selected content into a device so that the selected content is repeatedly presented, as recited by independent Claim 35." Br. 9. (4) "Shin does not describe selected content that is "locked in" the user device or "required to be presented" at the user device, as required by independent Claims 36 and 39." Br. 10. (5) "Shin also does not describe a mobile device including a memory for storing a plurality of profiles, each profile including an identifier indicative of the use of the locked- in selected content, as recited by independent Claim 42." Br. 11. (6) "In addition to the above distinctions, Shin does not describe the subject matter recited by dependent Claims 26, 33, 34, 38, and 41." Br. 12.

Argument (1). The Appellants argued that Shin describes a locking procedure that is different from the one claimed. According to the Appellants Shin describes a procedure by which a drafter of a document locks the document so that a potential reader can open the document only

after certain locking conditions are satisfied. Br. 6. According to the Appellants, the Shin locking procedure contrasts with that claimed because the claimed procedure "requires that the selected content be permitted to be operated upon in accordance with the selected locking requirement." Br. 7. Emphasis original. According to the Appellants, "the Shin publication describes a method of securing electronic documents and/or text messages by providing a locking function that prevents the electronic document or text message from being operated upon until some condition is satisfied (e.g., the entering of a correct password). Thus, it should be appreciated that this "locking function" term/concept of Shin is very different from the "locking requirement" term/concept of the claimed invention." (Br. 7). Emphasis original.

Argument (1) is not persuasive as to error in the rejection. There is no apparent difference between the Shin locking function and the claimed locking requirement. Shin places a locking condition on a document which must be overcome to open the document. A reader (or a mobile communication device; Shin [0029]) accesses the document via the locking condition. FF 9. See also Shin [0026]. Claim 1 requires "providing the selected content … with the at least the first locking requirement … to permit the selected content to be operated upon pursuant to the at least the first selected locking requirement." As with Shin, the claimed method places a locking condition on the content. As with Shin, the claimed method permits content to be operated on via the locking condition. The Appellants appear to be arguing that the Shin and claimed locking conditions are different; that a device using the Shin procedure must unlock the content whereas the claimed invention would lock the content. However, that

distinction is not reflected in the claim. The claim is broad enough to read on the Shin procedure. Furthermore, nothing in the claim or the Specification would lead one of ordinary skill in the art to construe the claim term "locking requirement" as limiting instructions for permitting one to operate on the content to those that yield a "locking," rather than an "unlocking," outcome. Moreover, there is no evidence that the instructions to effect a "locking" outcome would be any different from those that would effect an "unlocking" outcome. Both the Specification and Shin indicate that the user must input information via the locking condition to yield content which one can then operate upon.

Argument (2) is not persuasive as to error in the rejection. The Appellants argue that "[c]lain 21 of the present application recites that the "user device" is the eventual receiver of the selected content. In contrast, paragraph 0024 of Shin makes it clear that FIG. 3A describes the actions of *the drafter* of the electronic document that is to be locked." (Br. 8). Emphasis original. By this argument, the Appellants are arguing that the claimed method distinguishes over that of Shin in that the invention performs a locking action on the content at the user device. However, we see nothing in the claim limiting the performing of a locking action at the user device. The claim simply calls for "providing" a locking requirement at the user device. This encompasses providing a locking requirement that was applied to the content prior to transmitting to the user device, as Shin discloses.

Argument (3) is persuasive as to error in the rejection of claim 35. The Appellants argue that "Shin does not describe a content manager capable of locking selected content into a device so that the selected content

is repeatedly presented, as recited by independent Claim 35." (Br. 9). The Examiner relied upon Figs. 2A, 2B, and 4, and paragraphs 0010, 0011, 0022, and 0023 of Shin to argue that Shin anticipates the device of claim 35 (see *supra*). (Answer 6). The Examiner simply directs us to the indicated passages without explaining where in these passages Shin describes a content manager selectively locks and unlocks content in the manner claimed. Based on our review of that disclosure (FF3-9), we are unable to find the content manager as claimed. The required identity for establishing a prima facie case of anticipation has not been established. Accordingly, the rejection as to claim 35 is reversed.

Argument (4) is persuasive as to error in the rejection of claims 36 and 39. The Appellants argued that "Shin does not teach or suggest the repeated presentation of the selected content until the first selected locking requirement is met, as recited by independent Claims 36 and 39." (Br. 11). The Examiner relied upon Figs. 2A, 2B, and 4, and paragraphs 0010, 0011, 0022, and 0023 of Shin to argue that Shin anticipates the methods of claims 36 and 39. (Answer 3-4). The Examiner simply directs us to the indicated passages without explaining where in these passages Shin describes the repeated presentation of the selected content "until the at least the first selected locking requirement is met" (claim 36 and 39). Based on our review of that disclosure (FF 3-9), we are unable to find this step. The required identity for establishing a prima facie case of anticipation has therefore not been established. Accordingly, the rejection as to claims 36 and 39 is reversed. Because claims 37, 38, and 40 depend from claim 36, the rejection as to these claims is also reversed. Because claim 41 depends from claim 39, the rejection as to claim 41 is also reversed.

Argument (5) is persuasive as to error in the rejection of claim 42. The Appellants argued that "Shin also does not describe a mobile device including a memory for storing a plurality of profiles, each profile including an identifier indicative of the use of the locked-in selected content, as recited by independent Claim 42." (Br. 11). The Examiner relied upon Figs. 2A, 2B, and 4, and paragraphs 0010, 0011, 0022, and 0023 of Shin to argue that Shin anticipates the device of claim 42. (Answer 6). The Examiner simply directs us to the indicated passages without explaining where in these passages Shin describes the claimed memory for storing a plurality of profiles, each profile including "an identifier indicative of the use of the locked-in selected content" (claim 42). Based on our review of that disclosure (FF 3-9), we are unable to find this element. The required identity for establishing a prima facie case of anticipation has therefore not been established. Accordingly, the rejection as to claim 42 is reversed.

Argument (6) is persuasive as to error in the rejection of claim 26 but not persuasive as to error in the rejection of claims 33 and 34. (This argument was also applied to the rejection of claims 38 and 41. However, the argument as to these claims is moot given our decision *supra* to reverse the rejection as to these claims.)

The Appellants argued that Shin does not describe the operation of dispensing a reward as per claim 26. (Br. 12-13). The Examiner relied upon Figs. 2A, 2B, and 4, and paragraphs 0010, 0011, 0022, and 0023 of Shin to argue that Shin anticipates the device of claim 42. (Answer 6). The Examiner simply directs us to the indicated passages without explaining where in these passages Shin describes the claimed "operation of dispensing a reward to a user associated with the wireless mobile device subsequent to

notifying the network based device during said operation of determining" (claim 26). Based on our review of that disclosure (FF 3-9), we are unable to find this step. The required identity for establishing a prima facie case of anticipation has therefore not been established. Accordingly, the rejection as to claim 26 is reversed.

As to claims 33 and 34, the Appellants argued that "Shin also does not describe wherein the selected content comprises advertising content … ." (Br. 13). This argument is unpersuasive because the term "advertising" characterizes the content in terms of the *type* of information it contains. This sort of characterization is an effort to distinguish data based on nonfunctional descriptive material, which is, per se, patentably inconsequential. (*Cf. Ex parte Curry*, (BPAI 2005) (informative) (http://www.uspto.gov/web/offices/dcom/bpai/its/fd050509.pdf) ("Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious." (*Citing In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004) and *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983))).

CONCLUSIONS OF LAW

The Appellants have shown that the Examiner erred in rejecting claims 26, 35, 36, 37, 38, 39, 40, 41, and 42 as being anticipated by Shin.

The Appellants have not shown that the Examiner erred in rejecting claims 21, 22, 23, 24, 25, 27, 33, and 34 as being anticipated by Shin.

DECISION

The decision of the Examiner rejecting claims 21-27 and 33-42 under 35 U.S.C. § 102(e) as being anticipated by Shin is affirmed-in-part.

AFFIRMED-IN-PART

JRG

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